

Reply to Final Office Action
U.S. Application No. 10/716,478
Attorney Docket No. 02734.0609-00000

REMARKS

Applicant submits these Remarks in reply to the final Office Action mailed November 14, 2008 ("Office Action"). Claims 1-30 are pending in this application, of which claims 1, 11, and 21 are independent.

In the Office Action, the Examiner took the following actions:

- (1) rejected claims 1, 2, 7, 11, 12, 17, 21, 22, and 27 under 35 U.S.C. § 102(b) as being anticipated by Strozniak, "Sharing the Load" ("*Strozniak*"); and
- (2) rejected claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over *Strozniak*.

Applicant respectfully traverses these rejections as follows.

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I. 35 U.S.C. § 102(b)

Applicant respectfully traverses the Examiner's rejection of claims 1, 11, and 21 under 35 U.S.C. § 102(b) because *Strozniak* does not disclose what is particularly recited in each of these claims. To establish that *Strozniak* anticipates Applicant's claims under 35 U.S.C. § 102(b), the Examiner must show that *Strozniak* discloses the "identical invention . . . in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Additionally, the "elements must be arranged as required by the claim." See M.P.E.P. § 2131, citing *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Accordingly, Applicant respectfully traverses the rejection as follows.

A. *Strozniak* does not disclose "analyzing past load history based on dedicated and common carrier rates."

The Examiner argues that *Strozniak* inherently teaches the subject matter of claim 1. The portion of *Strozniak* cited by the Examiner reads as follows:

For example, General Mills and Atlanta-based Georgia-Pacific, a paper manufacturer, formed a 1,800 mile tour that included shipping a truckload of products from a Midwestern General Mills plant to a distribution destination on the East Coast. Georgia-Pacific used the same truck to transport its products on the return trip to a Midwest destination. That one tour is generating an annual shared cost-savings of more than \$730,000 for General Mills and Georgia-Pacific.

Strozniak, p. 4, ¶ 4 - p. 5, ¶ 1.

The Examiner summarized this passage, stating:

Strozniak teaches analyzing past load history based on dedicated and common carrier rates . . . General Mills considers the cost effectiveness of transporting Georgia-Pacific products instead of returning an empty truck, while Georgia-Pacific is considering the cost effectiveness of using the

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General Mills truck instead of the more expensive option of sending their own (dedicated) truck for transport

Office Action, p. 3.

However, *Strozniak* fails to disclose, teach, or suggest, either explicitly or inherently, at least the step of "analyzing past load history based on dedicated and common carrier rates" as recited in claims 1, 11, and 21. Indeed, *Strozniak* simply discloses a system by which companies can collaborate to reduce costs. *Strozniak* p. 1, ¶ 1 ("Companies now use technology to collaborate, which - if done properly - means sharing critical information and working to achieve mutual benefits"); *id.* p. 2, ¶ 1 ("On continuous-move tours companies can see a logistics savings that ranges between 5% to 25%, but the average savings is about 15%"). At no point does *Strozniak* disclose, teach, or suggest how an analysis of past load history plays a role in this collaborative cost saving operation.

Additionally, in the example, General Mills considers only the future cost of transporting Georgia Pacific products instead of returning an empty truck and Georgia-Pacific considers only the future cost effectiveness of using the General Mills truck instead of the more expensive option of sending their own (dedicated) truck for transport. There is no mention, disclosure, suggestion, or teaching of analyzing "past load history." Indeed, the Examiner virtually concedes this argument as her characterization of *Strozniak* fails to mention any considerations aside from the future costs of transporting the goods.

Further, independent claims 1, 11, and 21 require that such a past load history analysis be "based on dedicated and common carrier rates." *Strozniak* also fails to disclose, teach, or suggest this claimed subject matter.

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The entire premise of *Strozniak* relates to collaboration between companies to share dedicated carriers, not to "analyzing past load history based on dedicated and common carrier rates." See, e.g., *Strozniak*, p. 2, ¶ 1 ("Manufacturers and trucking companies are . . . reducing costs by sharing truck capacity and warehouse operations, and consolidating small shipments from several companies onto one truck."); *id.*, p. 2, ¶ 2 ("I think this is a major step-to collaborate with other companies to gain efficiencies - and I believe we see a lot more opportunities around collaboration."); *id.*, p. 4, ¶ 3 ("[T]he manufacturer's alliance used the Nistevo network to match routes that essentially would create round-trip or dedicated tours between manufacturers.") (emphasis added). The Examiner's reliance on the General Mills - Georgia Pacific example is misplaced as it fails to disclose, teach, or even suggest load analysis "based on dedicated and common carrier rates." In fact, this passage clearly indicates that only dedicated rates were considered. Had common carrier rates been considered, General Mills may have elected to send its shipment via common carrier instead of scheduling a tour with Georgia-Pacific products.

For at least these reasons, *Strozniak* does not disclose, teach, or suggest all recitations of Applicant's amended independent claims 1, 11, and 21.

B. *Strozniak* does not disclose "automatically creating the tour schematic based on analysis of the past load history."

Independent claims 1, 11, and 21 also recite, among other things, "automatically creating the tour schematic based on analysis of the past load history." *Strozniak* does not disclose, teach, or suggest this subject matter.

To support this argument the Examiner cites *Strozniak*, p. 4, ¶ 3, which states in full:

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To address the problem the manufacturer's alliance used the Nivesto network to match routes that essentially would create round-trip or dedicated tours between manufacturers. In other words, carriers would be guaranteed a truckload on their return trips, which reduces the cost for manufacturers because the trucks are not returning empty. This allows a carrier to provide a rate reduction to both manufacturers. Additionally, it increases the profit margins of carriers because of better asset utilization. What's more, it helps reduce turnover of drivers who no longer have to scramble to fill their trucks on the return trip. At the same time, service improves because drivers become familiar with the routes and develop business relationship with both the shippers and their customers.

Contrary to the Examiner's assertions, nothing in this passage discloses, teaches or suggests that the *Strozniak* system automatically creates a tour schematic or that it creates a tour history based upon past load history. In fact, the only references to automation are found elsewhere in the reference. *Id.*, p. 7, ¶ 2 ("Collaborative-logistics service Elogex uses its technology to automate the entire collaborative process, while not requiring any internal changes by participating companies."); *id.*, p. 7, ¶ 4 - p. 8, ¶ 1. ("[Elogex] automates all of the logistics details based on a company's rules, parameters, requirements, and contract agreements with carriers."). However, these excerpts are directed to automating the collaboration process between shipping entities, and fail to disclose, teach or suggest "automatically creating the tour schematic based on analysis of the past load history."

For at least these additional reasons, *Strozniak* does not disclose, teach, or suggest all recitations of Applicant's independent claims 1, 11, and 21.

C. The 35 U.S. C. § 102(b) rejections should be withdrawn.

As shown above, *Strozniak* fails to anticipate each of independent claims 1, 11, and 21. Because Applicant's dependent claims 2, 7, 12, 17, 22, and 27 each necessarily contain the recitations of independent claims 1, 11, and 21, *Strozniak* also

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does not disclose all recitations of those claims. Consequently, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(b) rejections based on *Strozniak* with respect to claims 1, 2, 7, 11, 12, 17, 21, 22, and 27.

II. 35 U.S.C. § 103(a)

Applicant respectfully traverses the Examiner's rejections of claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459

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(1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

As noted above in Part I, *Strozniak* does not teach, suggest, or disclose "analyzing past load history based on dedicated and common carrier rates," or "automatically creating the tour schematic based on analysis of the past load history," as claimed by Applicant in independent claims 1, 11, and 21. The Office Action does not clearly articulate any reason why one of ordinary skill in the art would have improved upon *Strozniak* to find the subject matter of claims 1, 11, and 21 obvious beyond the teachings of *Strozniak*. Therefore, no *prima facie* case of obviousness exists for those claims.

Moreover, the disclosure of *Strozniak* itself prevents modification of its teachings to reach the subject matter of claims 1, 11, and 21. Specifically and as previously noted, the disclosure example in *Strozniak* relied upon by the Examiner actually teaches away from "analyzing past load history based on dedicated and common carrier rates." "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02(vi) 8th Ed., Rev. 6 (Sept. 2007) (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P. Q. 303 (Fed. Cir. 1983); *cert. denied*, 469 U.S. 851 (1984)). "A reference may be said to teach away . . . if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought

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by the applicant." *Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999). *Strozniak* teaches a system of "reducing costs by sharing truck capacity and warehouse operations, and consolidating small shipments from several companies onto one truck." *Strozniak*, p. 2, ¶ 1. Thus, the essence of this approach is that shipping efficiencies can be improved by combining shipments from at least two companies onto one truck. Necessarily, common carrier rates are not analyzed as they would only benefit one company, and cuts against the level of "collaboration" contemplated by *Strozniak*. In other words, the addition of common carriers to the *Strozniak* analysis would necessarily undermine the stated goal of collaboration between companies. If the companies described in *Strozniak* began using common carriers, the system would break down as there would be fewer partners with whom companies could collaborate and share shipping costs. Essentially, by focusing on how to improve the efficiencies of multiple companies, *Strozniak* must avoid solutions which would benefit a single company to the possible detriment of another. Thus, because *Strozniak* teaches away from the claimed invention, the Examiner has not clearly articulated a reason why the claimed invention would have been obvious.

Moreover, Applicant challenges the Examiner's Official Notice as being improperly presented. The Examiner's general allegations that "it would have been obvious to one of ordinary skill in the art to consider threshold values when setting accent points" or that "it would have been obvious to one of ordinary skill in the art to consider business rules such as maximum and minimum length when setting accent points" are not sufficient to support taking Official Notice regarding at least Applicant's claims 3, 4, 8, 9, and 10.

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While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection . . . Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

M.P.E.P. § 2144.03(A).

Applicant therefore challenges the Examiner's presumed taking of Official Notice as improper as it is unsupported by documentary evidence, and based on the cited references and knowledge available to one of ordinary skill in the art, is not capable of instant and unquestionable demonstration as being well known. Neither the setting of access points based upon threshold values or maximum times and distances, as recited in claims 3, 4, 8, 9, and 10, are facts which are capable of instant and unquestionable demonstration as being "obvious" in the art. Thus, in addition to the arguments set forth above, if the Examiner continues to maintain the § 103(a) rejections based on the current grounds, Applicants respectfully request that the Examiner cite a reference pursuant to M.P.E.P. § 2144.03.

Finally, dependent claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30 each necessarily contain the recitations of independent claims 1, 11, and 21. Consequently, no *prima facie* case of obviousness exists with respect to claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30. Applicant, therefore, respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 3-6, 8-10, 13-16, 18-20, 23-26, and 28-30.

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III. Conclusion

The preceding remarks are based solely on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

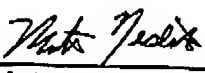
In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art reference cited against this application. Applicant therefore requests the entry of this reply, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. Finally, Applicant submits that the entry of this response would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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